

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-15 are pending in the application, with claim 1 being the only independent claim.

Claims 4-7 have been amended. Claims 8-15 have been added. Applicants believe no new matter is added by these amendments. Support for these amendments can be found, *inter alia*, at p. 17, lns. 34-35; p. 18, lns. 1-2; p. 20, ln. 36; p. 21, lns 1-15; and pp. 34-41 in the specification as filed.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Restriction under 35 U.S.C. § 112, first paragraph

The rejection of claims 4-7 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement is respectfully traversed.

Nature of the Invention and Breadth of the Claims

The Office states that "[c]laims 4 and 7 are directed to a composition and a method of preparing a composition wherein the said composition has an intended use of controlling unwanted microorganisms. Although the composition itself is deemed novel, the claimed intended use is not enabled for the full scope of the said use" (Office Action, page 3). Furthermore, the Office states that "the rejection of claims 4 and 7 can be overcome by removing the intended use from the claim language" (Office Action, page 5). Solely to advance prosecution, and not in acquiescence to the Office's rejection, claims 4 and 7 have

been amended to not recite "for controlling unwanted microorganisms." Withdrawal of the rejection is earnestly solicited.

Additionally, the Office states that "[c]laims 5 and 6 are directed to a method of controlling unwanted microorganisms by applying the composition of claim 4." (Office Action, page 3). Solely to advance prosecution, and not in acquiesce to the Office's rejection, claims 5 and 6 have been amended to recite "fungi and bacteria in the protection of crops or industrial materials" instead of "unwanted microorganisms." Support for these amendments can be found, *inter alia*, at page 17, Ins. 30-32, in the application as filed. Accordingly, a pharmaceutical method of control of the Ebola virus, as suggested by the Office, is not claimed. Accordingly, the rejection of claims 5 and 6 is rendered moot.

State of the Prior Art and Level of Predictability in the Art

The Office states that "[o]ne skilled in teh [sic] art can not [sic] predict which microorganisms can be controlled by using applicants claimed composition" (Office Action, page 4). However, the Office has provided no examples to substantiate the statements made about the state of the prior art or the predictability in the art. Therefore, the Office has failed to properly establish a *prima facie* case of failing to comply with the enablement requirement.

Claims 4 and 7 as amended claim compositions and not uses. Accordingly, the rejection of claims 4 and 7 is rendered moot. Claims 5 and 6 as amended specifically claim a method for controlling fungi or bacteria in the protection of crops or industrial materials. Furthermore, the specification as filed expands on the fungi and bacteria which can be

controlled by using the claimed method (*inter alia* at pp. 17-21) and provides representative examples (*inter alia* at pp. 34-41) for further clarity. Accordingly, the rejection of claims 5 and 6 is rendered moot.

Amount of Direction Provided by the Inventor and Existence of Working Examples

The Office states "[a]s far as controlling the hundreds of thousands of microorganisms encompasses [sic] by the term "unwanted microorganisms" applicant only states an intent to do so but provides no actual examples" (Office Action, page 4). As enumerated above, claims 4 and 7 as amended claim compositions and not uses. Accordingly, the rejection of claims 4 and 7 is rendered moot.

Also recited above, claims 5 and 6 as amended do not recite "unwanted microorganisms." Instead, claims 5 and 6 are drawn to methods for controlling fungi or bacteria in the protection of crops or industrial materials. Furthermore, the specification as filed provides specific direction on the subject of these methods (*inter alia* at pp. 17-21) and provides working examples (*inter alia* at pp. 34-41) for further clarity. Accordingly, the rejection of claims 5 and 6 is rendered moot.

Relative Skill of Those in the Art and Quantity of Experimentation Needed to Make or Use the Invention.

The Office recites "[o]ne skilled in the art would have to devise a testing regimen for each of the hundreds of thousands of microorganisms and test each one with the composition comprising the compound of formula (I)" (Office Action, page 5). As

enumerated above, claims 4 and 7 as amended claim compositions and not uses. Accordingly, the rejection of claims 4 and 7 is rendered moot.

Also recited above, claims 5 and 6 as amended do not recite "unwanted microorganisms." Instead, claims 5 and 6 are drawn to methods for controlling fungi or bacteria in the protection of crops or industrial materials. Furthermore, the specification as filed provides direction (*inter alia* at pp. 17-21), including working examples (*inter alia* at pp. 34-41), for those of skill in the art to practice these methods without undue experimentation. "The test [for undue experimentation] is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (citing *In re Angstadt*, 537 F.2d 489, 502-04, 190 USPQ 214, 217-19 (CCPA 1976)) (M.P.E.P. § 2164.06). The above recited portions of the specification provide specific direction to practicing the invention. Moreover, included in the specification as filed are working examples which render any necessary experimentation by one of ordinary skill in the art as merely routine. Therefore, the rejection of claims 5 and 6 is rendered moot.

Moreover, the rejection of claims 4-7 under 35 U.S.C. § 112, first paragraph, has been accommodated and/or rendered moot. Withdrawal thereof is earnestly solicited.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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